

### **REMARKS**

Claims 1-29 are pending in the Application and all have been rejected in the Office Action mailed on July 15, 2008. Claims 1, 6-9, 11, 16, 17, 19, 23, and 25 are amended by this response. Claims 1 and 11 are independent claims. Claims 2-10 and 24-26, and 12-23 and 27-29 depend from independent claims 1 and 11, respectively.

The Applicant respectfully requests reconsideration of the pending claims 1-29, in light of the following remarks.

#### **Amendments to the Claims**

Applicant has amended claims 1, 6-9, 11, 16, 17, 19, 23, and 25 to further clarify aspects of the claims, and to make the terms used in dependent claims consistent with their respective independent claims. Support for the amendments may be found, for example, at paragraphs [0020]-[0022], [0024], [0025], [0030], [0033], and [0034] of the Specification. Applicant respectfully submits that these amendments do not add new matter.

#### **Rejections of Claims**

Claims 1-25, 27, and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Johansson et al. (US Patent 5,418,837; hereinafter "Johansson") in view of O'Neil (US Patent 6,832,373). Claims 26 and 29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Johansson in view of O'Neil, and further in view of Rasmussen (US Patent 6,640,334).

The Applicant respectfully notes that although the Office omits claims 4, 18, and 19 from the list of claims rejected under 35 U.S.C. §103(a) shown on page 2, the detailed rejections of Section 4 includes claims 4, 18, and 19. Therefore, Applicant addresses the rejections of all of claims 1-25, 27, and 28 under 35 U.S.C. §103(a) over Johansson and O'Neil. The Applicant respectfully traverses the rejections.

Notwithstanding the above, Applicant has amended claims 1, 6-9, 11, 16, 17, 19, 23, and 25 as shown above. Applicant respectfully submits that the claims as amended define allowable subject matter, for the reasons set forth during prosecution, and those that follow.

**I. The Proposed Combination Of Johansson And O'Neil Does Not Render Claims 1-25, 27, And 28 Unpatentable**

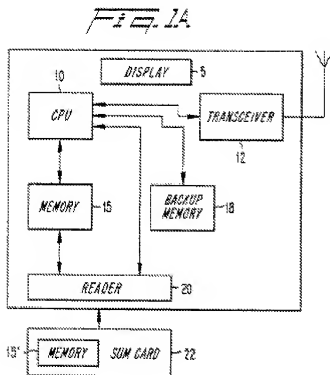
Claims 1-25, 27, and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Johansson in view of O'Neil.

The Applicant respectfully submits that the Office Action has failed to establish a case of prima facie obviousness for at least the reasons provided below. M.P.E.P. §2142 clearly states that "[t]he examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness." The M.P.E.P. §2142 goes on to state that "[t]hat the key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Company v. Teleflex Inc.* ... noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*."

With regard to claim 1, Applicant respectfully submits that claim 1 has been amended to recite, in part, "...wherein the removable electronic memory device comprises metadata information associated with the stored update information for updating of the at least a portion of the at least one of firmware and software." Applicant respectfully submits that the proposed combination of Johansson and O'Neill does not teach or suggest at least this aspect of Applicant's claim 1.

The Office admits that "Johansson doesn't expressly disclose at least one firmware component, functioning to update at least a portion of at least one of firmware and software and wherein using update information stored in the memory." See Office action at page 3. The Office asserts that the remaining features of claim 1 are taught by

Johansson's elements 5, 20, and 22 of Fig. 1A, and "... related text". See *id.* Applicant respectfully submits that the Office's vague reference to "related text" is not helpful in advancing the Application towards allowance, in that the Applicant is unable to read the mind of the Examiner to determine what text the Examiner feels is "related" to Applicant's claim features. Applicant will, however, address the teachings of Fig. 1A, which has been reproduced below.



The cited Fig. 1A of Johansson shows what Johansson describes as "...a block diagram of a mobile telephone and a SUM card according to a preferred embodiment of the present invention." See *id.* at column 3, lines 3-5. In that the Office has failed to specifically identify the relevant portions of the text of Johansson, Applicant reviews what is arguably the most relevant portions of Johansson, namely, column 4, line 34 to column 5, line 3, which is reproduced below.

FIG. 1A illustrates, in block diagram form, a mobile telephone terminal 1. The telephone 1 includes CPU 10 for controlling functions of the mobile telephone, a display 5 for

displaying information to the user and a transceiver 12 for sending and receiving telephone communications. A main memory 15 is provided for storing programs used by the mobile telephone. Mobile telephone 1 also includes a module reader 20 which can read a SIM card, a SUM card 22 according to the present invention, or other removable memory elements. According to one embodiment of the present invention, SUM card 22 includes only a memory 15' for storing the upgrading software. However, other configurations of the SUM card are possible as will be described with respect to FIG. 1B. The SUM card according to the present invention will have the same dimensions as currently known GSM SIM cards.

According to one embodiment of the present invention, a backup memory 18 may be provided to reduce the risks of malfunctions or errors due to changing software. The backup memory can be arranged for the entire contents of memory 15 or any part thereof. The backup memory 18 may be a separate memory unit as shown in FIG. 1A, or it may be a separate backup area provided in the memory 15 (not shown). In this area, only verified versions of the different information blocks will be written. If a malfunction or error takes place in the normal memory area, for example, as a result of an incorrect transmission from the SUM card, the information in the backup memory 18 will override the false information. This will be supervised by an error routine provided in the mobile telephone for handling malfunctions.

The backup memory may be of any type. According to a preferred embodiment, the memory is a flash memory or EEPROM or another similar non-volatile memory. The memory may consist of one or more memory for example, IC circuits.

The portion of Johansson shown above simply describes the various elements of Fig. 1A. There is nothing, however, in either Fig. 1A, or in the portion of Johansson that is arguably the "text" most "related" to the cited elements that teaches or suggests, at least, Applicant's feature "...wherein the removable electronic memory device comprises metadata information associated with the stored update information [in the memory] for updating of the at least a portion of the at least one of firmware and software." Applicant has reviewed the Johansson and O'Neil references, and has been

unable to identify any text or figure in either reference that teaches or suggests "metadata information" stored in a "removable electronic memory device" that is associated with "update information" stored in the memory of the electronic device and that is used for updating at least a portion of the at least one of firmware and software stored in the memory of the electronic device. If Applicant has inadvertently overlooked such teachings, Applicant respectfully requests that the Office specifically identify the relevant teachings (e.g., by column and line, or paragraph and line), and include a detailed explanation how and why the cited portion of the reference(s) teaches or suggests each of Applicant's claimed feature(s). Applicant respectfully notes that the M.P.E.P. §2142 recognizes that conclusory remarks such as those found in the instant Office action are not sufficient to establish a *prima facie* case of obviousness, stating in part, "...rejections on obviousness cannot be sustained with mere conclusory statements; instead there **must** be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

In addition, with regard to claim 7, Applicant respectfully submits that claim 7 now recites, in part, "...wherein the metadata information [in the removable electronic memory device] associated with the stored update information [in the memory] for updating of the at least one firmware and software [in the memory] comprises an indication of the availability in the memory of update information for the at least one of a firmware and software." Applicant respectfully submits that the Office cites only Johansson at Fig. 3 and "associated text", and column 7, lines 6-7 as teaching Applicant's claim 7. The Applicant respectfully submits that none of the cited portions of Johansson, nor any other portions of text or figures from Johansson teach or suggest "metadata information" associated with "update information" stored in the memory of an electronic device, let alone where the "metadata information" in the removable electronic memory device comprises an indication of the availability of update information in the memory of the electronic device. For at least these reasons, Applicant respectfully submits that the proposed combination of Johansson and O'Neil does not render claim 7 unpatentable, and requests reconsideration of the rejection of claim 7.

In addition, with regard to claim 8, Applicant respectfully submits that claim 8 now recites, in part, "...wherein the metadata information associated with the stored update information for updating of the at least one firmware and software comprises an indication of the success of an update of the at least one of firmware and software." Applicant respectfully submits that the Office cites only element 120 and of Johansson at Fig. 3 as teaching Applicant's claim 8. Applicant respectfully submits that Johansson makes reference to element 120 of Fig. 3 only in the text at column 7, line 67 to column 8, line 2, which states:

If the error checking routine at step 110 is clear, "OK" is shown in the display at step 120 indicating transmission has been successfully completed. At step 125, the mobile telephone is ready for use.

This portion of Johansson simply teaches that the character string "OK" is displayed on a display if an error checking routine is clear. Applicant respectfully submits that nothing in Fig. 3 or in the text shown above teaches or suggests "...wherein the metadata information [in the removable electronic memory device] associated with the stored update information [in the memory] for updating of the at least one firmware and software comprises an indication of the success of an update of the at least one of firmware and software." In fact, neither the cited figure or portion of Johansson, nor any other portions of text or figures from Johansson and/or O'Neill teach or suggest Applicant's claimed feature. For at least these reasons, Applicant respectfully submits that the proposed combination of Johansson and O'Neil does not render claim 8 unpatentable, and requests reconsideration of the rejection of claim 8.

Therefore, for at least the reasons set forth above, Applicant believes that claims 1-10, 24, and 25 are allowable over Johansson and O'Neil. Further, Applicant believes that claims 7 and 8 are independently allowable over the proposed combination as well. Accordingly, Applicant respectfully requests that the rejection of claims 1-10, 24, and 25 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

With regard to claim 11, Applicant respectfully submits that claim 11 has been amended to recite, in part, "...retrieving metadata information from the user removable electronic memory device; determining whether update information for updating the at least one of firmware and software is available in the memory, using the metadata information from the user removable electronic memory device; performing an update of at least a portion of the at least one of firmware and software using at least a portion of the metadata information from the user removable electronic memory device, if update information for updating the at least one of firmware and software is available in the memory; and refraining from performing an update of at least a portion of the at least one of firmware and software, if update information for updating the at least one of firmware and software is not available in the memory." Applicant respectfully submits that the proposed combination of Johansson and O'Neil does not teach or suggest at least these features of Applicant's claim 11.

Applicant respectfully submits that claim 11 as amended recites limitations similar to those of amended claim 1, which Applicant has shown is allowable over the proposed combination of Johansson and O'Neill for at least the reasons set forth above. Because claims 12-23 and 27-29 depend from allowable claim 11, Applicant respectfully submits that claims 12-23 and 27-29 are also allowable over the proposed combination of references, for at least the same reasons.

In addition, with regard to claim 16, Applicant respectfully submits that claim 16 recites limitations similar to claim 7, and is allowable for at least the reasons set forth above with respect to the rejection of claim 7.

In addition, with regard to claim 19, Applicant respectfully submits that claim 19 now recites, in part, "...metadata information from the user removable electronic memory device comprises the location of at least one of the update package and the server." The Office admits that Johansson does not disclose "...receiving an update package from a server; and the receiving update information comprising an update package from a server, performed using a wireless network; and the information from the user removable electronic memory device comprises the location of at least one of the update package and the server." The Office then relies on O'Neill at column 11, line

30 to column 12, line 10, stating, in part, "...O'Neil discloses updating the client from a server side location as well as performing updates wirelessly (11:30 -12:10). Therefore, It would have been obvious, to one with ordinary skill in the art at the time the invention was made to combine Johansson and O'Neil because, it would enable updating the device over a server." See Office action of July 15, 2008 at page 9. Applicant respectfully disagrees, and submits that nothing in the cited portion of O'Neill at column 11, line 30 to column 12, line 10 teaches or suggests "...metadata information from the user removable electronic memory device comprises the location of at least one of the update package and the server." Applicant respectfully submits that because the Office admits that Johansson fails to teach these features, and Applicant has shown that the cited portion of O'Neil does not teach or suggest these features, it necessarily follows that the proposed combination fails to teach or suggest at least these aspects of Applicant's claim 19. Applicant respectfully requests reconsideration of the rejection.

In addition, with regard to claim 20, Applicant respectfully submits that claim 20 recites, in part, "...storing status information in the user removable electronic memory device, if an update was performed;..." The Office cites only Johansson at column 4, lines 9-14 as teaching this feature of Applicant's claim, stating "...data area that can be altered during or after a complete upgrading procedure", col. 4, lines 9-14)." See Office action of July 15, 2008 at page 10. Applicant respectfully submits that the mere disclosure of a "data area that can be altered during or after a complete upgrading procedure" does not teach or suggest "storing status information". Further, the disclosure of Johansson does not teach Applicant claim 20 feature "...refraining from storing status information in the user removable electronic memory device, if an update was not performed..." Johansson merely states that the "SUM Card" may have a "data area that can be altered during or after a complete upgrading procedure", but does not teach or suggest that the "data area" is not altered if an upgrading procedure is not completed. For at least these reasons, Applicant respectfully submits that claim 20 is not rendered unpatentable by the proposed combination of Johansson and O'Neil.

In addition, with regard to claim 22, Applicant respectfully submits that claim 22 recites, in part, "...wherein at least one of a need to restart or reboot and a type of



reboot is resident in the user removable electronic memory device.” The Office cites only Johansson at column 6, lines 52-56 as teaching this feature of Applicant’s claim 22, stating, in part, “...Johansson discloses the method of claim 21 where at least one of a need to restart or reboot and a type of reboot is resident in the user removable electronic memory device (“If the card installed is not valid ... re sets the telephone”, col. 6, lines 52-56).” Applicant respectfully submits that the invalidity of a card (the “SUM Card” of Johansson) is different from and does not teach or suggest either “a need to restart or reboot” or a “type of reboot” that is resident in a “user removable electronic memory device”. The Office provides nothing more than conclusory remarks regarding the alleged obviousness, which the Office recognizes is insufficient grounds for an obviousness rejection. For at least these reasons, Applicant respectfully submits that the proposed combination of Johansson and O’Neil does not render claim 22 unpatentable.

In addition, with regard to claim 23, Applicant respectfully submits that claim 23 recites, in part, “...verifying whether the retrieved metadata information is at least one of appropriate and authentic;...” The Office again cites only Johansson, and asserts that Johansson discloses “...verifying whether the retrieved information is at least one of appropriate and authentic (“check that correct data is transferred ...”, col. 5, lines 35 - 39);...” Applicant has addressed the teachings of Johansson column 5, lines 35-39 above. Applicant respectfully submits that “check[ing] that correct data is transferred...” “into the telephone” by comparing at the “CPU 225” the data previously transferred to the telephone with the data in the “SUM Card” is different from and does not teach or suggest verifying “metadata information” (which Johansson does not teach) is at least one of “appropriate” and “authentic”. The comparison of Johansson simply teaches that the data in the “SUM Card” and in the “telephone” of Johansson are the same. For at least these reasons, Applicant respectfully submits that the proposed combination of Johansson and O’Neil does not render Applicant’s claim 22 unpatentable.

Based at least upon the above, Applicant respectfully submits that the proposed combination of Johansson and O’Neill does not render Applicant’s claim 11 unpatentable. Because claims 12-23 and 27-29 depend from allowable claim 11,

Applicant also respectfully submits that claims 12-23 and 27-29 are allowable over Johansson and O'Neill as well, for at least the same reasons. Further, Applicant has shown that claims 16, 19, 20, 22, and 23 are independently allowable. Accordingly, Applicant respectfully requests that the rejection of claims 11-25, 27, and 28 under 35 U.S.C. §10(a) be reconsidered and withdrawn.

## **II. The Proposed Combination Of Johansson And O'Neil With Rasmussen Does Not Render Claims 26 And 29 Unpatentable**

Applicant respectfully submits that claims 26 and 29 depend indirectly from claims 1 and 11, respectively. Applicant respectfully submits that claims 1 and 11 are allowable over the proposed combination of references, in that Rasmussen fails to remedy the shortcomings of Johansson and O'Neil, set forth above. Because claims 1 and 11 are allowable over the proposed combination of references, Applicant respectfully submits that claims 26 and 29 that depend therefrom are also allowable as well. Accordingly, Applicant respectfully requests reconsideration of the rejection of claims 26 and 29.

## **Conclusion**

In general, the Office action makes various statements regarding the claims and the cited references that are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. However, Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicant believes that all of pending claims 1-29 are allowable. Should the Examiner disagree or have any questions regarding this submission, the Applicant invites the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Dated: October 15, 2008

/Kevin E. Borg/

Kevin E. Borg  
Reg. No. 51,486

Hewlett-Packard Company  
Intellectual Property Administration  
Legal Department, M/S 35  
P.O. Box 272400  
Fort Collins, CO 80527-2400